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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1316N-001683

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On February 15, 2006

Signature

Typed or printed name Michael J. SchmidtApplication Number
10/662,662Filed
09/15/2003First Named Inventor
Simon Anne de Molina, et al.Art Unit
3683Examiner
Thomas J. Williams

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

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The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor

Signature

 assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

Michael J. Schmidt

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Telephone number

 attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 February 15, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

 *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/662,662

Filing Date: 09/15/2003

Applicant: Simon Anne de Molina, et al.

Group Art Unit: 3683

Examiner: Thomas J. Williams

Title: SHOCK ABSORBER STAGED VALVING SYSTEM

Confirmation No.: 1855

Attorney Docket: 1316N-001683

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The Examiner has rejected Claims 1, 3-7, 10, 11 and 13-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,823,922 to Ergun in view of U.S. Pat. No. 3,432,008 to Henry-Biabaud. Applicants respectfully traverse this rejection.

Independent Claims 1, 11 and 17 each define that each of the single direction rebound valves actuates at a different individually adjustable rebound valve opening pressure and each of the single direction compression valves actuates at a different individually adjustable compression valve opening pressure. This provides for

successive valve opening to provide a desired damping characteristic to be achieved by delaying the opening of the second (or more) valves as described in paragraph 23 on page 7.

The Examiner first goes to Ergun where he states that Ergun teaches that the valves can be designed to actuate at different opening pressures to achieve a desired damping characteristic (see column 5, lines 46-47). What Ergun teaches at column 5, lines 46-47 is that valve springs and pins can be modified to effect the desired damping characteristics. What Ergun does not teach is the individual adjustment of each compression valve assembly and each rebound valve assembly as defined by independent Claims 1, 11 and 17 of the present invention.

The Examiner gets around this lack of disclosure in Ergun by stating that it is his opinion that this implies to one of ordinary skill in the art that the valves in Ergun can be individually adjusted. The problem with the Examiner's opinion is that it goes against the teachings of Ergun. Ergun, in column 6, lines 42-43 states that the structure of the piston assembly 28, which the valve assemblies are a part of, is advantageous in its interchangeability of components. This teaches that while the damping characteristics can be changed by modifying the valve springs and pins, all of the valve springs and pins must be modified in the same manner or the stated advantage of interchangeability of components in Ergun is destroyed. Clearly, Ergun does not suggest this modification it clearly teaches against it.

The Examiner attempts to support his position by relying on Henry-Biabaud which teaches adjustable valve assemblies. Henry-Biabaud teaches two oppositely arranged main valves 3 and 3a where valve 3 is the only compression valve and valve

3a is the only rebound valve. Neither valve 3 nor valve 3a is positioned in piston 22. Thus, Henry-Biabaud may teach a different valve setting between a compression valve and a rebound valve, Henry-Biabaud does not teach the stepped opening of compression and rebound valves which is defined by the present invention. As discussed above, combining Henry-Biabaud with Ergun goes against the teachings of Ergun. Even if Henry-Biabaud were combined with Ergun, the combination would produce different opening pressures between rebound and compression, but it would not produce the different individually adjustable rebound valve opening pressure and the different individually adjustable compression valve opening pressures defined by pending Claims 1, 11 and 17. The only motivation for providing the different individually adjustable rebound and compression valve opening pressures is Applicants' disclosure and the Examiner's improper use of hindsight gleaned from the Applicants' disclosure.

Thus, Applicants believe Claims 1, 11 and 17 patentably distinguish over the art of record. Likewise, Claims 3-7, 9, 10, 12-16, 18 and 19, which ultimately depend from one of these claims, are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Independent Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ergun in view of Henry-Biabaud and in view of Katz (U.S. Pat. No. 4,624,346). Applicant respectfully traverses this rejection.

Claim 20 is a method claim which includes the limitations of arranging at least two single direction rebound valves and two separate single direction compression valves to open toward a respective face of the piston. Rotating a nut to adjust each of the rebound valves to open sequentially upon exposure to a predetermined set of first

increasing fluid pressures and preconditioning each of the compression valves to open sequentially upon exposure to a set of second increasing fluid pressures.

The above discussion with regards to Ergun and Henry-Biabaud apply to this rejection also. Katz discloses a multi-ratio hydraulic shock absorber where separate valves are activated based on the position of the stroke of the shock absorber and not sequentially opened upon exposure to a set of increasing fluid pressures as defined by Claim 20. Column 1, lines 39-42 of Katz states "It is an object of the present invention therefore to provide a different ratio hydraulic braking, according to the position of the stroke, and this in both directions of movement and independent speed."

Thus, Applicants believe Claim 20 patentably distinguishes over the art of record. Likewise, Claims 21-23, which ultimately depend from Claim 20, are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

By: 
Michael J. Schmidt, 34,007

Dated: February 15, 2006

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